

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the specification

The specification is amended, as shown in the foregoing AMENDMENT TO THE SPECIFICATION, to provide a more descriptive title, as required by the Office action. It is respectfully submitted that no new matter is added, as the change simply corrects a minor informality.

Entry of the AMENDMENT TO THE SPECIFICATION is respectfully requested in the next Office communication.

2. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claims 1-4 are amended to remove reference numerals. It is respectfully submitted that no new matter is added, since the use of reference numerals does not affect the scope of the claims (MPEP § 608.01(m)).

Claim 1 is further amended in order to clarify that there is no invocation of 35 U.S.C. § 112, 6<sup>th</sup> paragraph. Specifically, in the case of amendments effectively changing an original claim element expressed as a “means plus function” that could raise a presumption of claim expression under 35 U.S.C. 112, 6<sup>th</sup> paragraph to a structural expression or to an expression removing the presumption of a “means-plus-function” statement, it is not intended to narrow the claim so amended for purposes of patentability, but rather to place the claim in a form considered to be intended by the applicant from a foreign country where claim limitations described in terms of means-plus-function do not have the same effect as under U.S. practice. Thus, such amendments are intended to establish a full range of equivalents to the claim elements so amended under the U.S. doctrine of equivalents and beyond the range associated

with “means-plus-function” expressions according to 35 U.S.C. 112, 6<sup>th</sup> paragraph, just as if the claim so amended was presented originally in its amended form. Thus, it is respectfully submitted that no new matter is added as the minor changes merely provide clarity without changing the scope of the claims.

Claims 5 and 6 are left unchanged.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

3. Rejection of claims 1-6 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 4,387,845 (*Mefferd*)

Reconsideration of this rejection is respectfully requested, on the basis that the *Mefferd* patent fails to disclose each and every recited element of pending claim 1. The remaining claims depend from claim 1, and are therefore patentable as containing all of the recited elements of claim 1, as well as for their respective recited features.

By way of review, the embodiment of pending claim 1 requires a positioning apparatus that includes a plug member projected from a first block toward a leading end for insertion into a positioning hole formed in the second block. An inclined outer surface is provided on the plug member. An annular sleeve member is arranged outside the inclined outer surface. The sleeve member has an inclined inner surface facing the inclined outer surface. At least one of the inclined inner surface and the inclined outer surface are provided on a pair of opposed projections. Escape portions are formed between the projections to allow for axial misalignment of the positioning hole with respect to the plug member (specification page 11, line 19 through page 12, line 4).

In contrast to the above described embodiment, the *Mefferd* patent fails to disclose at least a pair of opposed projections for forming at least one of the inclined inner surface and the inclined outer surface, and escape portions formed between the projections in order to accommodate axial misalignment of the positioning hole with respect to the plug member.

The *Mefferd* patent discloses an apparatus designed to allow fittings to be welded to cylindrical tubes without causing warping of the tubes due to the high temperatures involved (abstract; col. 1, lines 6-8). In order to accomplish this objective, an expanding mandrel 34 is provided to apply pressure to the internal walls of a cylinder in order to prevent the walls of the cylinder from collapsing or warping during a welding process. The mandrel 34 has sufficient resiliency to expand radially outwardly in response to outward radial pressure on the walls of the mandrel (col. 3, lines 41-44).

The internal structure of the mandrel 34 is arranged with an axial bore 42 extending therethrough and having a central reduced straight diameter portion 44 and two outwardly diverging cone shaped tapered portions 46, 48 at its opposite ends (col. 3, lines 28-32).

The outward radial pressure to expand the mandrel 34 is provided by a tapered mandrel 32 and a tapered block 38, each having respective cone shaped surfaces 54, 62 to matingly engage with the cone shaped surfaces 48, 46 of the expanding mandrel 34 (col. 3, line 51 through col. 4, line 2). A threaded draw rod 36 connects to the tapered mandrel 32 and the tapered block 38, and when rotated in a first direction draws the tapered mandrel 32 and the tapered block 38 towards each other such that the engagement of the cone shaped surfaces 54, 62 and 48, 46 causes the expanding mandrel 34 to radially expand (col. 4, lines 11-29).

In contrast to pending claim 1, the *Mefferd* patent fails to disclose a pair of opposed projections for forming at least one of an inclined inner or inclined outer surface. As defined by Webster's Online Dictionary, a projection is "a jutting out" or "a part that juts out," which appropriately describes the projections illustrated and discussed in the pending application.

The Office action refers to reference numerals 42 and 48 in the *Mefferd* patent to indicate a pair of opposed projections. However, as discussed above, reference numeral 42 refers to the axial bore within the expanding mandrel, and reference numeral 48 refers to a cone shaped surface. Thus, no projections are shown in the

*Mefferd* patent. This is particularly true since the cone shaped surfaces of the expanding mandrel are specifically shown to be uniformly shaped for mating engagement with the uniform cone shaped surfaces of the tapered mandrel and the tapered block.

Further, the *Mefferd* patent does not disclose any escape portions between a pair of opposed projections, since no pair of opposed projections is described. Additionally, the Office action refers to reference numerals 64 and 66 in the *Mefferd* patent to indicate escape portions formed between a pair of opposed projections. However, reference numerals 64 and 66 in the *Mefferd* patent specifically refer to the inlet 66 and the outlet 64 of a cooling passageway 64 that is formed within the walls of the expanding mandrel 34 (col. 4, lines 3-6). Thus, the cooling passage of the *Mefferd* patent may not be considered to be escape portions formed between a pair of opposed projections, as required by pending claim 1.

Further still, as discussed above, the escape portions of the claimed embodiment allow for axial misalignment between the plug portion and the positioning hole. There is no such corresponding structure disclosed in the *Mefferd* patent. In fact, since the purpose of the expanding mandrel of the *Mefferd* patent is to maintain the cylindrical shape of the tube by preventing warping, the expanding mandrel must actually be perfectly aligned with the axis of the cylindrical housing 12 of the *Mefferd* patent. Otherwise, there is a chance that warping of the cylinder 12 may occur if there is any axial misalignment between the cylinder 12 and the expanding mandrel 34.

Thus, in view of the above discussion, the *Mefferd* patent fails to disclose at least a pair of opposed projections for forming at least one of the inclined inner surface and the inclined outer surface, and escape portions formed between the projections, as required by pending claim 1.

Accordingly, since the *Mefferd* patent fails to disclose at least a pair of opposed projections for forming at least one of the inclined inner surface and the inclined outer surface, and escape portions formed between the projections, the

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*Mefferd* patent fails to disclose every feature of pending claim 1 and withdrawal of this rejection is respectfully requested.

As mentioned above, applicants submit that independent claim 1 is patentable and therefore, claims 2-6, which depend from claim 1, are also considered to be patentable as containing all of the elements of claim 1, as well as for their respective recited features.

4. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,



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